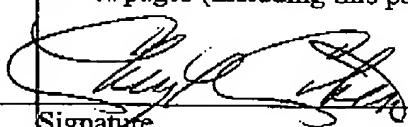


U.S. Serial No. 10/805,935
Confirmation No.: 1026
Filed: March 22, 2004
Title: THEFT DETERRENT BACKPACK
Inventor: Cheryl F. Cohen
Art Unit: 3727
Examiner: J. PASCUA

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Attorney's Docket No.: CFC0001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant/Appellant: C. Cohen
Serial No. : 10/805,935
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REPLY
BRIEF ON APPEAL UNDER 37 CFR 41.41

Sir:

This Reply Brief on Appeal is submitted pursuant to 37 CFR 41.41 in response to the Examiner's Answer mailed December 21, 2005. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 503462.

U.S. Serial No. 10/805,935
Reply Brief on Appeal

page 1 of 8

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I. Status of Claims

Claims 1-24 remain pending in the present application and are now under appeal, of which claims 1, 12 and 22 are independent claims. Claims 1-24 have been rejected over the prior art. Specifically, claims 1-9, 11-19 and 21-24 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,154,332 (Williams et al.). Claims 1-24 are also rejected under 35 U.S.C. §103(a) as obvious over Williams et al. Claims 10 and 20 are rejected under 35 U.S.C. §103(a) as obvious over Williams et al. in view of U.S. Patent No. 3,530,919 (May).

II. Grounds of Rejection to be Reviewed on Appeal

1. Whether claims 1-9, 11-19 and 21-24 are unpatentable under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,154,332 (Williams et al.)?
2. Whether claims 1-24 are unpatentable under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,154,332 (Williams et al.)?
3. Whether claims 10 and 20 are unpatentable under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,154,332 (Williams et al.) in view of U.S. Patent No. 3,530,919 (May)?

III. Argument

Appellant respectfully traverses each of the Examiner's statements set forth in the Examiner's Answer.

The Examiner's first argument is that the term "backpack" in the preamble of the claims is not to be accorded patentable weight. In his remarks the Examiner states

"Williams et al. clearly discloses a backpack (58) comprising an enclosure that has back panel (28) and a front panel (26) forming a main compartment. There is nothing in appellant's claims that explicitly required the 'at least two panels forming a main compartment' of the backpack itself. A broad reasonable interpretation of appellant's claims does not preclude backpack within an enclosure formed by a plurality of panels as disclosed by Williams et al." (Examiner's Answer: p. 3, ll. 17-22)(emphasis added).

Appellant respectfully disagrees with the Examiner's claim interpretation. The preamble itself, and in particular the structural "backpack" preamble limitation, restricts the limitation in the body of the claims of "at least two panels forming a main compartment" to that of the backpack itself. Following the principles set forth by the Court of Customs and Patent Appeals in the case *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (1951) since the term "backpack" in the preamble defines the structure of the article being produced it should be construed as if in the balance of the claim itself. Instead, the Examiner has merely ignored the "backpack" preamble structural limitation relying on features of the enclosure rather than the backpack of Williams et al. to read on the present claimed invention. The Examiner has failed to provide any legal support for disregarding or not according patentable weight to the term "backpack" in the claim preamble. In order for the present claimed invention to be anticipated by Williams et al. the prior art reference must teach each limitation of the present invention. Reading into the body of the claims the preamble structural backpack limitation expressly requires "at least two panels forming a main compartment" of the backpack itself. To the contrary, Williams et al. fails to disclose features of the backpack 58 itself that anticipate the present claimed limitations.

Similarly, the preamble structural "backpack" limitation also restricts the limitation in the body of the claim of "a releasable securing device for accessing the main compartment" to that of the backpack itself. In contrast, the zippers 14a, 14b, 14c of the enclosure 16 disclosed by Williams et al. are for accessing the interior of the enclosure 16

and provides no means for accessing the main compartment of the backpack 58 itself, as claimed. Appellant asserts that since the backpack 58 alone without reliance on the separate enclosure 16 component fails to read on the present claimed invention directed exclusively to the backpack itself the Examiner has failed to establish that Williams et al. anticipates the present claimed invention.

With respect to independent claim 22, it is the Examiner's position that "Williams et al. clearly discloses the releasable securing device (14c) extending along front panel (26), top panel (32) and back panel (28) for accessing the main compartment of the enclosure that surrounds the backpack (58)" (emphasis added)(Examiner's Answer: p. 4, ll.7-9). Again the Examiner is relying on the teachings in Williams et al. directed to features of the enclosure 16 rather than that of the backpack 58 itself, despite the fact that the preamble "backpack" structural limitation should be read into the body of claim 22 to limit "a releasable securing device for accessing the main compartment" to that of the backpack itself.

The next issue addressed by the Examiner concerns whether Williams et al. shows the backpack with zippers oriented in a substantially lateral orientation when the backpack is disposed in an upright position. It is the Examiner's position that "the appealed claims do not explicitly recite zippers on a backpack" (Examiner's Answer: p. 4, ll. 13-14). For the same reasons expressed above, appellant traverses the Examiner's interpretation and maintains that despite the term "backpack" not being expressly recited in the body of the claims, the "backpack" structural limitation in the claim preamble should be construed as if in the balance of the claim.

With respect to claims 9 and 19, the Examiner maintains "Williams et al. clearly shows the zipper (14c) extending laterally across the top panel (32) when the backpack is oriented in an upright position as shown in Fig. 4" (Examiner's Answer: p. 4, ll. 15-17). Similarly, with respect to claims 3 and 14 the Examiner argues that the zipper 14c extending across the top panel (32) in Williams et al. meets the claimed limitations (Examiner's Answer: p. 4, ll. 18-21). Again for the reasons stated above appellant asserts that the Examiner's reliance on the zipper 14c of the enclosure 16, rather than on features associated with the backpack 58 itself fails to read on the present claimed invention as found in claims 3, 9, 14 or 19.

Next, the Examiner asserts that Williams et al. teaches a zipper that extends sufficiently along the back panel of the backpack so that the terminating end rests against a wearer's body when worn. Specifically, the Examiner states

"backpack shoulder straps are attached to the backpack at a location below the shoulders of the wearer. See Fig. 5. Therefore, the location of the terminating ends of the zippers (14a, 14b, 14c) in Williams et al. with respect to the attachment location of backpack shoulder straps to the backpack would inherently result in the terminating end of the zipper (14c) resting against a wearer's body. Appellant's reliance on Fig. 5 of Williams et al. to show the terminating end not resting on the back of a user is misplaced because Fig. 5 does not accurately portray the terminating end of the zipper (14c) being located adjacent the location where the backpack shoulder straps exit the enclosure as shown in Fig. 4" (Examiner's Answer: p. 5, ll. 8-16).

The Examiner's observations regarding the alleged inaccuracies in scale or proportions of the terminating end of the zipper 14c and attachment of backpack straps shown in Figure 5 relative to that shown in Figure 4 are merely speculative and irrelevant. In Williams et al. the specification expressly states that "Third zipper 14c originates on front panel 26, travels over top panel 32, and terminates between but just above termination point 38 of zippers 14a and 14b on back panel 28." (Col. 3, ll. 48-51)(emphasis added). Such an arrangement is in line with the goal of the invention in which "the orientation of the zippers allows the backpack to be worn by the user while the backpack is inside the enclosure. A removable flap of material provides a passageway for the shoulder straps of the backpack to pass through the invention and be worn by the user." (Col. 2, ll. 10-15) It is therefore illogical and inconceivable how the terminating end 14c of the zipper could rest against the user's body when the reference, to the contrary, expressly discloses it as being above the point of attachment of the shoulder straps to the back panel so as to permit passage of the shoulder straps through the flap when worn. Accordingly, appellant maintains that the prior art reference fails to disclose or suggest the releasable securing device/zipper chain "is adapted to extend sufficiently along the back panel of the backpack so that the termination end rests against a wearer's body when worn", as found in dependent claims 11 and 21.

The Examiner also argues that the limitation "wherein the releasable securing device is adapted to extend sufficiently along the back panel of the backpack so that the terminating end rests against a wearer's body when worn" (emphasis added) does not

constitute a limitation in a patentable sense. Appellant respectfully traverses the Examiner's interpretation that this claim limitation fails to provide any patentable weight. MPEP section 2173.05(g) recognizes that there is nothing inherently wrong with defining some part of an invention in functional terms. This same section further cites *In re Venezia*, 530 F. 2d 956, 189 USPQ 149 (CCPA 1976) wherein the court held that the limitation "members adapted to be positioned" when directed to a kit of component parts serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. Similarly, in the present application the claimed limitation "wherein the releasable securing device is adapted to extend sufficiently along the back panel of the backpack so that the terminating end rests against a wearer's body when worn" also serves to precisely define present structural attributes of interrelated component parts of the claimed backpack. Accordingly, the claimed limitation must be accorded patentable weight.

Lastly, on page 6, lines 1-19 of the Examiner's Answer the Examiner paraphrases Appellant's arguments by stating that "there is no suggestion to combine the Williams et al. and May references". In the Appeal Brief the Appellant also traversed the combination of obviousness references on the basis that the references expressly taught away from such modification. MPEP section 2145(X)(D)(2) expressly recognizes that references cannot be combined where the reference teaches away from their combination. "It is improper to combine references where the references teach away from their combination" (MPEP section 2145(X)(D)(2) (citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Since the Williams et al. references teaches away from modification as taught by May for the reasons described in detail in the Appeal Brief, appellant submits that the Examiner has failed to set forth a *prima facie* case of obviousness.

For the foregoing reasons, appellant submits that Williams et al. does not teach, either alone or in combination, each and every element of claims 1-24. Accordingly, Appellant submits that claims 1-24 are patentable over the prior art of record.

Respectfully submitted,

Dated: 1-24-06



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